said reorientation means are activated by said processor, and wherein said second outcome consists of said plurality of symbols comprising said first outcome.

REMARKS

The Office Action dated October 23, 2002 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art and certain typographical inexactitudes have been rectified to provide better form. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

It is believed that the foregoing revisions to the claims are within the metes and bounds of the recently articulated Supreme Court *Festo* case, in that all equivalents susceptible to capture have been retained in that one skilled in the art, at the time of this amendment, could not have reasonably be expected to have drafted a claim that would have literally encompassed any other equivalent.

Drawings

The drawings have been objected to under 37 C.F.R. 1.83(a) because they fail to show elements disclosed in the specification, specifically symbols (20), paylines (22), and matrix (21). Figures 3 and 4 have been corrected to show these elements.

In addition, the drawings have been objected to under 37 C.F.R. 1.83(a) because they fail to show every feature of the invention specified in the claims. The "definite language" referred to by the Examiner at page 2 of the Office Action (e.g., "only if", "if and only if", "initial") follow the original construction of the flowchart.

For example, note that if a maximum bet is played and the first (initial) outcome is a winning combination, the flowchart then directs the player to play again or cash out. Only if the first outcome is not a winning outcome is the comparison made to see if the first outcome can be made into a winning combination after reorientation.

The flowchart of Figure 1 has been corrected to recite that the changing of the initial combination into the winning combination is based on a rule set, which takes into account the "alternative second outcomes" of claim 21 (see exemplary rule set number 8 at page 12 of the specification). Other minor changes have been made that are consistent with the specification and claims as filed.

The corrected drawings should overcome the objections to the drawings.

Rejections under 35 U.S.C.§ 112

The Examiner has rejected claims 1, 3, 6 through 13, and 15 through 22 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, at page 3 of the Office Action, the Examiner has requested that applicant point out in the specification where it is disclosed that "the output is first examined for its presence on the paytable and if there is no match another comparison takes place and the movable functions are engaged".

The Examiner's kind attention is directed to the original Figure 1, which indicates a first comparison ("winning combination?"), and upon receiving a "no" answer to that query, a second comparison (can combination be made into winning combination?". Additionally, at page 10, line 15-18 of the original specification, it

states "if the initial outcome does not correspond to an outcome on the paytable, all of the displayed symbols and their locations are compared to the paytable to determine whether a winning outcome may be produced by reorienting the symbols according to a rule set". Further, at page 11, line 4, the specification states "The following rule set controls potential reorientation *when the initial outcome does not correspond to the paytable*". There are, necessarily, at least two comparisons to a paytable.

In addition, original claim 1 in the application recited "said processor including a comparison means between said first outcome and a paytable, and including means to change the location of one or more symbols if said first outcome is not recognized by said paytable such that said one or more symbols move from their first outcome orientation to a different area in said RXC matrix to provide a second outcome recognized by said comparison means to be on said paytable". Two comparisons take place.

The Examiner has also rejected claim 22 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing the particularly point out and distinctly claims the subject matter which applicant regards as the invention. Specifically, the Examiner questions the limitation "alternative second outcomes" in line 3 of claim 22, believing there to be insufficient antecedent basis for this limitation.

The Examiner's kind attention is directed to page 12, lines 6-8 of the original specification: "A move can be based on precedence. For example, the *highest winning combination* recognized by the paytable may be used, the *lowest winning combination* may be used, or a bonus event combination of symbols might be used." This rule set is activated after the initial outcome was not found on the paytable (see

page 11, line 4). If more than second outcome can be made by reorienting the initial outcome, one second outcome will be chosen (e.g., by a rule set such as that stated above). All other possibilities would be considered "alternative second outcomes".

Similarly, original claim 10 recites " . . . wherein said symbols move . . . to produce said second outcome . . . wherein said second outcome is recognized by said comparison means to be the highest-ranking combination on said paytable of *possible combinations of said symbols of said first outcome orientation*" (emphasis added). The italicized language is also present in claim 11. These "possible combinations of said symbols of said first outcome orientation" may also be referred to as "alternative second outcomes", as stated in claim 21.

The exemplary rule set and original claim language for claims 10 and 11 provides sufficient antecedent basis for the limitation "alternative second outcomes".

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1, 3, 6 through 13, and 15 through 22 under 35 U.S.C. § 103(a) as being unpatentable over Bessho'169 in view of Arnold (GB) '781.

With regard to Bessho '169, undersigned respectfully submits that the symbol-moving features of the instant invention are enabled only if the initial outcome is not recognized by the paytable. If the initial outcome is recognized by the paytable, the player is awarded and the game ends. If, and only if, the initial outcome is not present on the paytable, then the visible symbols are compared to the paytable according to a rule set. Bessho's specific condition detecting circuit (47) is always active after the reels (5 to 9) stop moving (col. 3, lines 51-58), so the output is only

checked against the paytable once. By contrast, an additional condition is present in the present invention.

The Examiner has cited Arnold (GB) '781 for teaching "a fruit machine having the equivalent means to award if the first outcome is recognized on the paytable" (page 5 of the Office Action). Page 1, line 130 through page 2, line 3 of Arnold states "the selector then determines on a random basis whether or not a primary nudge feature game is to be made available to a player". Also, "the secondary feature game is only available on a random basis" (page 2, lines 109-110)

Moreover, the nudge game of Arnold (whether primary or secondary) is player-controlled. "[d]uring the period of the timer (10) the player is able to step the reels (1 to 3), one at a time in individual steps corresponding to one symbol position on the reel periphery" (page 2, lines 6-10; similarly in page 2, lines 77-79). In the instant invention, the processor makes the comparisons and performs the reorientation. The claims have been amended to explicitly state this limitation, and the rejections under 35 U.S.C. § 103(a) should be withdrawn.

Undersigned has read these patents carefully and has failed to uncover the basis by which the Examiner has combined these references to support an obviousness type rejection. Stated alternatively, there is no teaching within these citations that would warrant the combination of elements proposed by the Examiner and it is respectfully stipulated that applicant's structure would still not be obtained thereby. A specific teaching within one of the references suggesting the combination is required:

Undersigned provides the Examiner guidance with respect to rejections under 35 U.S.C. § 103, which is binding, compelling precedent from the Court of Appeals for the Federal Circuit.

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 F.2d at 1143, 227 U.S.P.Q. at 551. Citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 & n. 14, 221 U.S.P.Q. 929, 933 & n. 14 (Fed. Cir. 1984).

"Something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination." *Lindemann Mashcinenfabrick GmbH v. American Hoist and Derrick Co.*, 780 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 437 F.2d 1044 (Fed. Cir. 1988).

These precedents, decisions from the Court of Appeals for the Federal Circuit, are binding precedents with respect to the manner in which patents showing the prior art can be combined. When relying on these principles, it is apparent that the prior art cannot be combined as the Examiner has proposed because there is no teaching suggesting such a combination.

It is Black Letter Law the Patent and Trademark Office's burden is to establish a prima facie case of obviousness. The Patent and Trademark Office has met its burden only when it fully describes: "1) What the reference discloses, teaches and

suggests to one skilled in the art; 2) What the reference lacks in disclosing, teaching or suggesting vis-à-vis the claimed features; 3) What particular teaching or suggestion is being relied upon either via a reference itself or knowledge of person of ordinary skill in the art; 4) A statement explaining the proposed modification in order to establish the prima facie case of obviousness; and finally 5) the motivation behind the statement of obviousness which comes from three sources: a) teachings of the prior art; b) nature of the problem to be solved; or c) knowledge of persons of ordinary skill in the art", *see In re Rouffet* 47 USPQ2d 1453 (Fed. Cir. 1998).

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

Dated: April 22, 2003

Respectfully Submitted:

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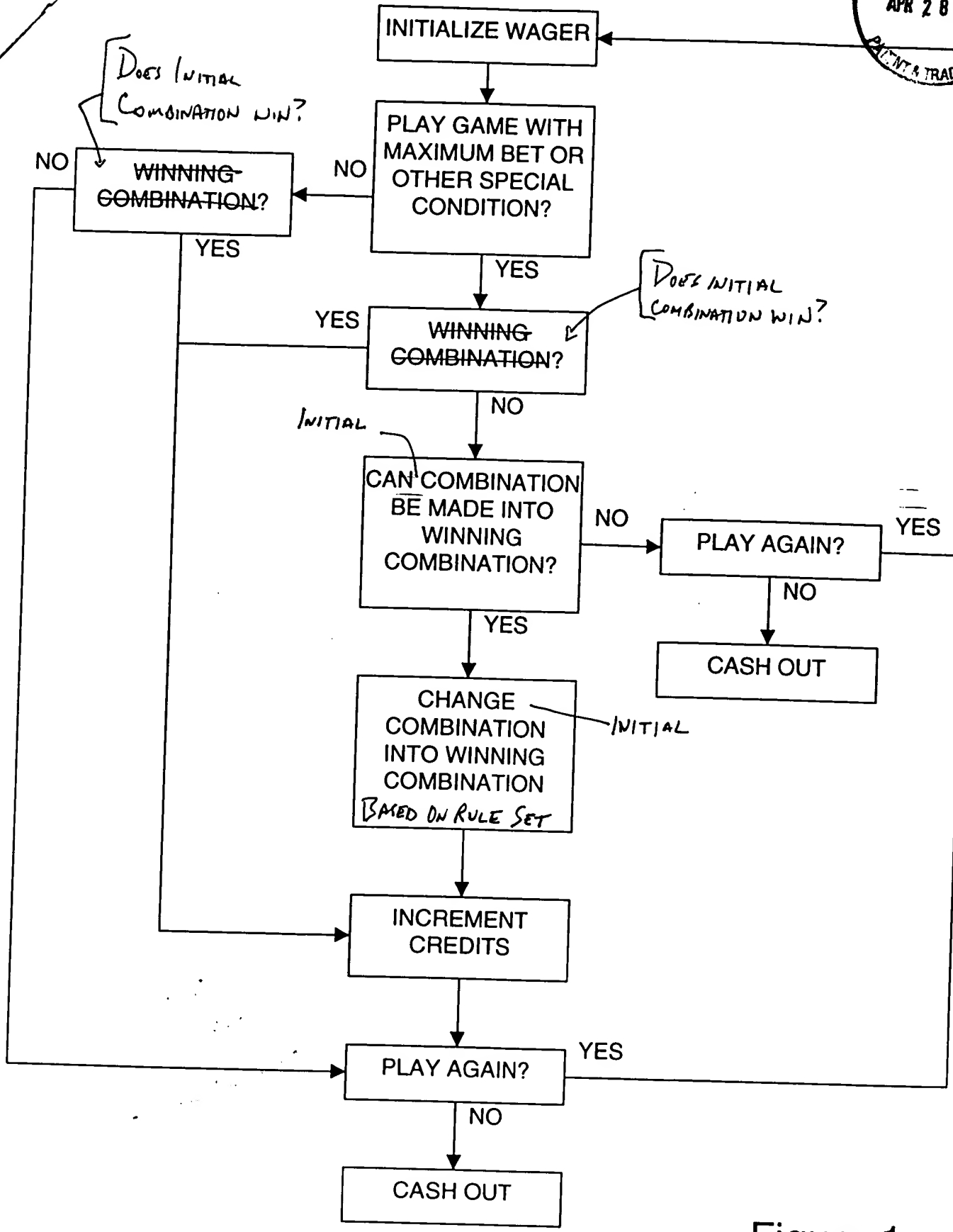

Figure 1

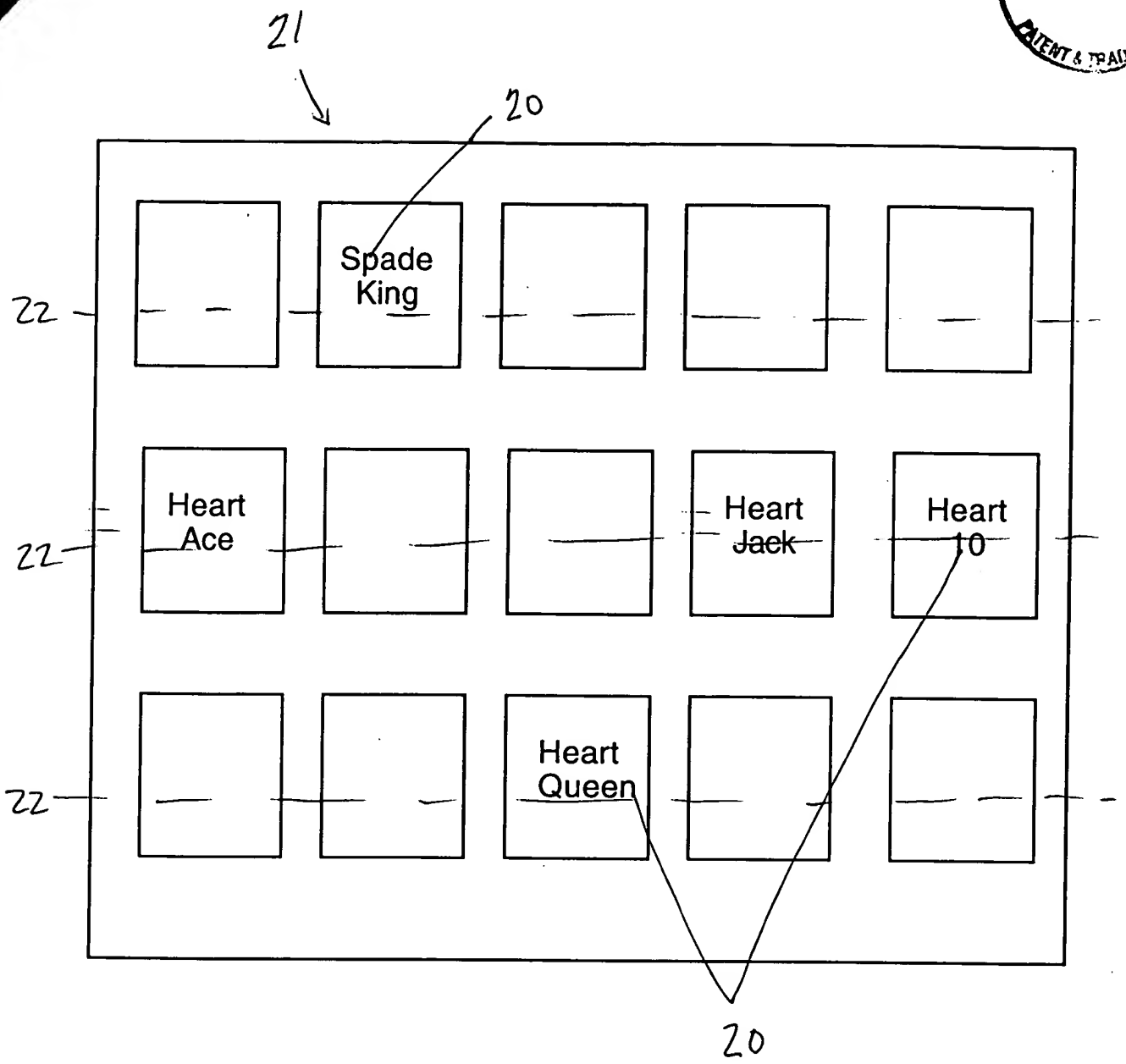

Figure 4

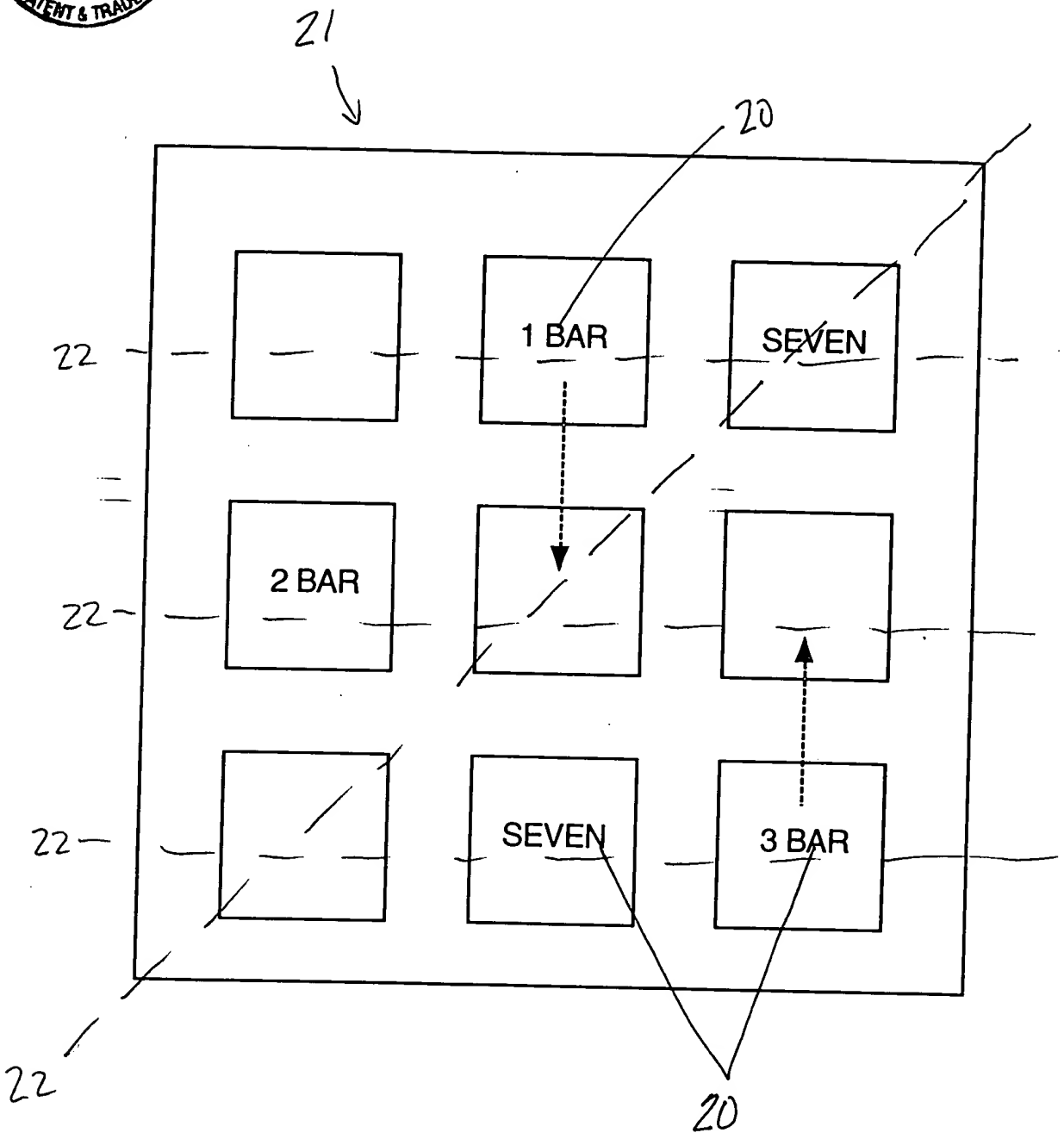

Figure 3

Bracketed and Underlined Claims

Claim 1 (amended) - A gaming device, comprising, in combination:

a display,

a plurality of decision making means,

wagering means,

a processor including random means operatively coupled to said display, said decision making means and said wagering means to receive and transmit information therebetween,

said display including a plurality of symbols oriented in an RXC matrix,

said plurality of symbols changing as a function of said wagering means and said random means to provide a first outcome,

said processor including a comparison means between said first outcome and a paytable, means to bestow an award if said first outcome is recognized on said paytable and including processor-activated means to change the location of one or more symbols only if said first outcome is not recognized by said paytable and only when said one or more symbols can move from their first outcome orientation to a different area in said RXC matrix according to a rule set to provide a second outcome[,] such that said second outcome is recognized by said comparison means to be on said paytable [and] is said processor-activated means to bestow an award then activated.

Claim 10 (amended) - The gaming device of claim 1 wherein said symbols move from said first outcome orientation to produce said second outcome recognized by said comparison means to be on said paytable[,] only when said second outcome is recognized by said comparison means to be the highest-ranking combination on said paytable of possible combinations of said symbols of said first outcome orientation.

Claim 11 (amended) - The gaming device of claim 1 wherein said symbols move from said first outcome orientation to produce said second outcome[,] only when said second outcome is recognized by said comparison means to be the lowest-ranking combination on said paytable of possible combinations of said symbols of said first outcome orientation.

Claim 12 (amended) - The gaming device of claim 1 wherein said processor-activated means to change the location of one or more symbols if said first outcome is not recognized by said paytable is active during all times of operation.

Claim 13 (amended) - The gaming device of claim 1 wherein said processor-activated means to change the location of one or more symbols if said first outcome is not recognized by said paytable is not active during all times of operation.

Claim 15 (amended) - A method for wagering on a gaming device, including the steps of:

making a wager to enable the gaming device,

evoking chance means to trigger an initial outcome,

displaying [the] said initial outcome,

comparing [the] said initial outcome to a paytable,

awarding credits if the initial outcome is found on [the] said paytable,

determining whether an outcome found on [the] said paytable can be made by permuting [the] said initial outcome only if [the] said initial outcome is not on [the] said paytable,

manipulating [the] said initial outcome according to a rule set to produce a winning outcome only when [the] said initial outcome is not on [the] said paytable, and

awarding credits for the manipulated winning outcome found on [the] said paytable.

Claim 16 (amended) - An apparatus for wagering, comprising, in combination:

wagering means,

means for displaying a plurality of symbols in an RXC matrix with N paylines,

means for comparing displayed symbols to a paytable,

means for incrementing an award due in the presence of a winning outcome, and

processor-activated means for changing the location of said displayed symbols to produce a winning outcome only if [the] said displayed symbols are not

found on [the] said paytable and only when [the] said displayed symbols can be reoriented according to a rule set to an outcome recognized by [the] said paytable whereupon said means [to] for incrementing an award is enabled.

Claim 17 (amended) - The device of claim 1 wherein said symbols are derived from a conventional deck of playing cards and said symbols include processor-activated means to change suit if said first outcome is not recognized but changing suit will result in an award.

Claim 19 (amended) - A gaming device, comprising in combination:

a display; and

a processor and random number generator operatively coupled and intercoupled with said display, said processor and random number generator having comparison means and means to bestow an award, wherein said processor and random number generator produce a first outcome on said display, said comparison means compare said first outcome to a paytable, and said means to bestow an award are activated if said first outcome is found on said paytable, and wherein reorientation means are activated by said processor to reorient said first outcome to a second outcome if and only if said first outcome is not found on said paytable, and said second outcome is found on said paytable.

Claim 20 - A method of gaming, the steps including:

enabling a gaming device;

generating a first outcome;

comparing said first outcome to a paytable;

awarding credits if said first outcome is present on said paytable;

reorienting said first outcome to produce a second outcome if and only if said first outcome is not present on said paytable and if and only if said second outcome is present on said paytable, wherein reorientation is processor-controlled; and

awarding credits [if said second outcome is present on said paytable].

Claim 22 (amended) - A method of gaming, the steps including:

enabling a gaming device;

generating a first outcome;

comparing said first outcome to a paytable;

awarding credits if said first outcome is present on said paytable;

manipulating said first outcome according to a rule set if and only if said first outcome is not present on said paytable, and if and only if said second outcome is present on said paytable, wherein manipulation is entirely processor-controlled; and

awarding credits [if said second outcome is present on said paytable].